# REMARKS

By this amendment, Applicants have amended claims 1, 7, 14, and 20. As a result, claims 1-22 remain pending in this application, with claims 14-22 currently being withdrawn from consideration. These amendments are being made to facilitate early allowance of the presently claimed subject matter. Applicants do not acquiesce in the correctness of the objections and rejections and reserve the right to pursue the full scope of the subject matter of the original claims, or claims that are potentially broader in scope, in the current and/or a related patent application. Reconsideration in view of the following remarks is respectfully requested.

## A. Disposition of Claims

Initially, Applicants note that the Office Action Summary indicates that claims 1-13 are pending. Applicants note that this is in error. In particular, claims 14-22 remain pending in the application, but are currently withdrawn from consideration. Applicants respectfully request correction of the indication.

## B. Restriction Requirement

In the Office Action, the Office maintains the restriction requirement and examines claims 1-13. With respect to the restriction requirement, Applicants previously elected claims 1-13 with traverse. In Applicants' arguments, Applicants requested that, should the Office maintain the restriction requirement, the Office:

(a) make a specific finding as to what features in Group I are patentable over Group II; and

(b) make a specific finding as to the serious burden imposed on the Examiner by

considering all pending claims since all claims are classified in the same

class/subclass.

However, in the Office Action, the Office merely restates its conclusion that "the examination of

both groups would have required further search and consideration and would have thus been

burdensome to the examiner." Office Action, p. 7.

Initially, Applicants note that the standard for restriction is that the further search and

consideration must pose a "serious burden", not just any additional burden as stated by the

Office. See, e.g., MPEP 803. To this extent, the MPEP states that "a serious burden on the

examiner may be *prima facie* shown by appropriate explanation of separate classification, or

separate status in the art, or a different field of search". MPEP 803. In the present case, the

inventions have the same classification, which requires the same field of search. As a result,

Applicants again respectfully request rejoinder of claims 14-22 and consideration of all pending

claims. In the alternative, Applicants again request that the Office make the specific findings

cited above.

## C. 101 Rejections

Further, the Office rejects claims 1-13 under 35 U.S.C. § 101 as allegedly lacking a

practical application of a judicial exception. By this response, Applicants have amended claims

1 and 7 to expressly include storing the performance value(s) for use in evaluating the data

mining algorithm(s). Support for this amendment is clearly found throughout the specification,

which discusses a computer implementation of the invention. As a result, Applicants

respectfully request withdrawal of the rejections of claims 1-13 as allegedly lacking a practical application of a judicial exception.

## D. 102 Rejections

Further, the Office rejects claims 1-8 and 11-13 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Publication No. 2003/0212678 (Bloom). Applicants respectfully submit that the Office fails to show that Bloom discloses each and every feature of the claimed inventions.

For example, in support of its rejection, the Office relies entirely on paragraph 0015 of Bloom. This portion of Bloom discusses calculating a "figure of merit" using "a weighted sum of positive and negative relative accuracy". Bloom, paragraph 0015. Initially, Applicants are unclear as to the content of paragraph 0015 that allegedly discloses "obtaining a set of goals" and "assigning a weight to each goal" as in claims 1 and 7. In general, a goal comprises an objective, or a purpose toward which an endeavor is directed. See, e.g., goal, Dictionary.com, *The American Heritage® Dictionary of the English Language, Fourth Edition*, Houghton Mifflin Company, 2004, http://dictionary.reference.com/browse/goal (accessed: May 22, 2007). However, paragraph 0015 of Bloom does not discuss any type of goal or objective of a model, let alone obtaining a set of goals or assigning a weight to each goal as in claims 1 and 7. In sharp contrast, Bloom merely discusses positive and negative relative accuracy and an assigned weight. Regardless, Applicants have amended claims 1 and 7 to expressly state that the data mining algorithm(s) are configured to solve the set of goals.

In light of the above, Applicants respectfully request withdrawal of the rejections of claims 1-13 as allegedly being anticipated by Bloom. However, should the Office maintain its

position that paragraph 0015 of Bloom allegedly discloses "obtaining a set of goals" and "assigning a weight to each goal" as in claims 1 and 7, Applicants respectfully request that the Office clarify how it is interpreting the claimed goals and the teachings of Bloom.

**E. 103 Rejections**

Further, the Office rejects claim 9 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bloom in view of Applicants' admitted prior art. Initially, since claim 9 depends from claim 7, Applicants respectfully submit that claim 9 is allowable by dependency in view of the arguments presented above. Further, Applicants submit that Applicants' admitted prior art does not address the deficiencies of Bloom discussed above.

Further, the Office alleges that "Bloom teaches... a plurality of business problems and taxonomies in figure 4." Office Action, p. 6. Applicants respectfully disagree. In particular, Fig. 4 of Bloom is limited to various components in a database management system. Bloom, paragraph 0021. The database management system performs several tasks, which are executing programs. Bloom, paragraphs 0165, 0168. As a result, Applicants respectfully submit that Fig. 4 of Bloom is unrelated to the business taxonomies and business problems in claim 9. However, should the Office maintain its interpretation of Bloom, Applicants respectfully request that the Office particularly point out those portions of Bloom's Fig. 4 that allegedly correspond to business taxonomies and business problems.

Still further, the Office alleges that "[t]he applicant admits that it was known in the art at the time of the invention to select data mining algorithms based on the selection of problems in para 5 of applicants [sic] specification." Office Action, p. 6. Initially, Applicants note that paragraph 0005 of the specification is unrelated to selecting data mining algorithms based on the

selection of problems. To the contrary, paragraph 0005 discusses running a data mining algorithm against sample data multiple times, each with different tuning parameter(s).

In an attempt to understand the Office's rejection, Applicants assume that the Office may have been referring to paragraph 0003 of the specification, which states that "the data mining algorithm can be selected based on the goals that a user is seeking to accomplish (e.g., classification, fraud detection, etc.)." Specification, paragraph 0003. Assuming, *arguendo*, this is the case, Applicants note that this discussion states that the data mining algorithm is selected based on goals, not " based on the selection of problems" as alleged by the Office. As a result, Applicants respectfully submit that Applicants' admitted prior art does not disclose the selection of data mining algorithms based on the selection of problems as alleged by the Office. However, should the Office maintain this interpretation of Applicants' admitted prior art, Applicants respectfully request that the Office particularly point out the interpretation of Applicants' admitted prior art with respect to the business taxonomy and business problem as in claim 9.

Still further, the Office states that "neither [Bloom nor Applicants' admitted prior art] teaches these problems being further grouped into taxonomies. However, this feature would have been well known at the time of the invention..." Office Action, p. 6. Applicants disagree with the Office's Official Notice. In particular, Applicants disagree that selecting a business problem based on a business taxonomy when evaluating a set of data mining algorithms was not well known in the art at the time of the invention. As a result, Applicants request that the Office provide some documentary evidence in support of its position should the Office again reject claim 9.

In light of the above, Applicants respectfully request withdrawal of the rejection of claim 9 as allegedly being unpatentable over Bloom in view of Applicants' admitted prior art.

Further, the Office rejects claim 10 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bloom in view of U.S. Patent Publication No. 2004/0068476 (Provost). Since claim 10 depends from claim 7, Applicants respectfully submit that claim 10 is allowable by dependency in view of the arguments presented above. Further, Applicants submit that Provost does not address the deficiencies of Bloom discussed above. As a result, Applicants respectfully request withdrawal of the rejection of claim 10 as allegedly being unpatentable over Bloom in view of Provost.

**F. Conclusion**

Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response should one be necessary and/or in a related patent application, either of which may seek to obtain protection for claims of a potentially broader scope.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better

condition for allowance, the Examiner is invited to contact Applicants' undersigned

representative at the number listed below.

Respectfully submitted,

/John LaBatt/

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